

REMARKS

I. Status of the Application

Claims 1-7, 11-20, 23, 25, 27-29, 31, and 33-41 were pending. With this amendment, Applicants amended claims 1-3, 5-7, and 33, cancelled claims 4 and 13, and added claims 42-43. The amendments and the newly added claims are supported by the application as filed. Accordingly, entry of the amendments is respectfully requested.

II. Claim Rejections

A. 35 USC § 103

The Examiner rejected claims 1, 3-7, 13, 27-29, 31-33, and 35-39 as being unpatentable over US2004/0230676 (Spivack) in view of US2005/0131724 (Clay) and further in view of US20020013729 (Kida); claims 2 and 14 over Spivack in view of Clay, in view of Kida, and further in view of US20020184096 (Kawahara); claims 11, 12, 25, and 40 over Spivack in view of Clay, in view of Kida, and further in view of US2004/0103024 (Patel); and claims 15-20, 23, 34, 35, and 41 over Spivack in view of Clay, in view of Kida, and further in view of US20040186776 (Llach), all under 35 U.S.C. 103 The Examiners rejections are respectfully traversed.

1. Claims 1, 5 and 33

Claim 1 as amended recites:

obtaining, at an offer exchange server, an advertiser offer for placing an advertisement in at least one web page associated with an advertisee, the offer comprising conditions including a first set of one or more user context conditions required by the advertiser for presentation of the advertisement to the user in the at least one web page;

obtaining, at the offer exchange server, an advertisee offer for placing an advertisement in the at least one web page associated with the advertisee, the advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user in the at least one web page;

obtaining, at the offer exchange server, user context information that indicates the context of the activities of the user in relation to the advertisee;

Claim 1 is therefore directed to a method that creates an exchange for virtual items, i.e., advertisements to be placed on a web page. In this respect, advertisers specify their conditions for placing an advertisement on a web page associated with an advertisee, the advertisees specify their conditions, and the system monitors the user's activities in relation to the advertisee, and place the advertisers' add in the web page when the match between these conditions and activities occur. For example, some of the conditions may be search terms, the user's activity may be submitting a search phrase to a search engine, and the advertisements may be presented in a search results page, as recited in claim 3. Applicants submit that the references cited by the Examiner fail to disclose or otherwise suggest the features of claim 1 as specifically claimed. Claims 5 and 33 includes similar features and are patentable for at least the same reasons as for claim 1. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

2. Dependent Claims

The dependent claims are allowable for at the same reasons as the claims from which they depend as well as for additional reasons. While deemed unnecessary to argue the additional reasons at this time, given the arguments presented above, Applicants reserve the right to present such argument should it become necessary or desirable to do so. Even so, Applicants request that the Examiner not limit his or her inquiry to the patentability of the independent claims in light of the arguments presented above. Rather, Applicants request that the Examiner consider all of the amendments to the claims and any newly added claims with the same level of attention as that of the independent claims.

3. Motivation to Combine References

Applicants note that the Examiner has combined at least three references in rejecting each of the pending claims. However, the Examiner has not cited any references or provided any evidence for the motivation to combine the references relied on by the Examiner. Applicants remind the Examiner that burden lies on the Examiner to establish a prima facie case of obviousness. To do so, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine teachings. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Moreover, the motivation to combine references must be supported under the substantial evidence standard. *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001); *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1383-1386 (Fed. Cir. 2001). A conclusory or common sense statement as to the factual question of motivation is insufficient to establish a prima facie case of obviousness absent evidentiary support. *In re Lee*, 277 F.3d at 1343-1345; *In re Zurko*, 258 F.3d at 1385. *Innogenetics v. Abbott Laboratories*, 512 F.3d 1363, 1373-74 (Fed. Cir. 2008). Accordingly, Applicants demand that the Examiner produce documentary evidence for the proffered motivation if the rejections are to be maintained.

III. Conclusion

For the above reasons, Applicants submit that the pending claims are patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of the pending claims are respectfully solicited.

The Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

Respectfully submitted,

/ Antonio Papageorgiou/

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